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| 10/648,380 | 08/27/2003 | Yoshiyuki Tamai | 325772033000 | 5365 |

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| EXAMINER |
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PATEL, CHIRAG R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/648,380 | TAMAI ET AL. | |
| | Examiner | Art Unit | |
| | CHIRAG R. PATEL | 2454 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 1-21 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 8, 2009 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 recites the limitation "the discriminated result" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 1-12, the broadest reasonable interpretation of "recording medium" directed to and covers both non-transitory media and transitory propagating signals *per se*. Examiner suggests an amendment "non-transitory recording medium" This amendment would not be considered new matter.

See MPEP 2106, "See, *e.g.*, *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. op. at 18)("A transitory, propagating signal like Nuijten's is not a 'process, machine, manufacture, or composition of matter.' . Thus, such a signal cannot be patentable subject matter.").

As per claims 13-20, "e-mail transmission apparatus" is directed to "software *per se*", and thus fails to falls within a statutory category of invention. The claims fails to positively recite hardware structure that meets a statutory category of invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 9-10, 13, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirani et al. - hereinafter Kirani (US 2002/0016818) in view of Bandini et al. - herinafter Bandini (US 2002/0169954)

As per claims 1 and 13, Kirani discloses a recording medium in which a program for making a computer execute processing is stored, the processing, comprising:

detecting a recipient's domain name of an e-mail to be sent with data attached to the e-mail from a recipient's address of the e-mail; ([0115], Figure 5A, item 503; detects recipient's address -which includes domain name - in order to "determine whether the recipient's device type is already known and/or if this recipient has already opted for a format preference for delivered attachments")

re-formatting the data into the decided format if a current format of the data is different from the decided format; ([0116], Figure 5B; item 506)

attaching one of the re-formatted data having the decided format or the current format data having the decided format as an attachment to the e-mail; and ([0116], Figure 5B: item 507)

transmitting one of the re-formatted data having the decided format or the current format data having the decided format to the recipient's address as the attachment of the e-mail, ([0116], Figure 5B: item 508)

Kirani fails to disclose deciding a format of the data to be attached to the e-mail depending on the detected recipient's domain name;

wherein the decided format relates to limiting the ability of a user associated with the mail to electronically handle the data.

Bandini discloses deciding a format of the data to be attached to the e-mail depending on the detected recipient's domain name. ([0032]; [0036]; Policies can advantageously be applied to users, either individually or by e-mail domains; Figure 4: item 410)

wherein the decided format relates to limiting the ability of a user associated with the mail to electronically handle the data ([0035])

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Kirani to disclose deciding a format of the data to be attached to the e-mail depending on the detected recipient's domain name; wherein the decided format relates to limiting the ability of a user associated with the mail to electronically handle the data. The motivation for doing so would have been to provide centralized control over e-mail messages exiting and entering an organization. ([0006])

As per claims 5 and 17, Kirani / Bandini disclose the recording medium as recited in claim 1. Bandini discloses wherein, in cases where the data is transmitted simultaneously to a plurality of recipients, ([0024]) the program stored in the recording

medium makes the computer decide the format of the data every recipient and format the data into respective decided formats. ([0032]; [0036]; Policies can advantageously be applied to users, either individually or by e-mail domains)

As per claim 9, Kirani / Bandini disclose the recording medium as recited in claim 1. Bandini discloses wherein the program stored in makes the computer discriminate whether the recipient belongs to the same organization of a sender based on the detected recipient's domain name and decide a format of the data to be attached to the e-mail based on the discriminated result. ([0036]; Policies can advantageously be applied to users, either individually or by e-mail domains)

As per claim 10, Kirani / Bandini disclose the recording medium as recited in claim 9. Bandini discloses wherein, in cases where it is discriminated that the recipient belongs to an organization different from an organization of the sender, ([0029]; Figure 3) the program stored in the recording medium makes the computer format the data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization. ([0032],[0036]; Policies can advantageously be applied to users, either individually or by e-mail domains)

As per claim 21, Kirani discloses an e-mail transmitting method, comprising:

detecting a recipient's domain name of an e-mail to be transmitted with data attached to the e-mail from a recipient's address of the e-mail; ([0115], Figure 5A, item 503; detects recipient's address -which includes domain name - in order to "determine whether the recipient's device type is already known and/or if this recipient has already opted for a format preference for delivered attachments")

re-formatting the data into the decided format if the current format of the data is different from the decided format; ([0116], Figure 5B; item 506)

attaching one of the re-formatted data having the decided format or the current format data having the decided format as an attachment to the e-mail; and ([0116], Figure 5B: item 507)

transmitting one of the re-formatted data having the decided format and the current format data having the decided format to the recipient's address as the attachment of the e-mail. ([0116], Figure 5B: item 508)

Kirani fails to disclose deciding a format of the data depending on the detected recipient's domain name. Bandini discloses deciding a format of the data depending on the detected recipient's domain name. ([0032]; [0036]; Policies can advantageously be applied to users, either individually or by e-mail domains; Figure 4: item 410)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Kirani to disclose deciding a format of the data depending on the detected recipient's domain name. The motivation for doing do would

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have been provide centralized control over e-mail messages exiting and entering an organization. ([0006])

Claims 4, 8, 16 and 24, rejected under 35 U.S.C. 103(a) as being unpatentable over Ferlitsch et al. – hereinafter Ferlitsch (US 2006/0209342) in view of Bandini (US 2002/0169954).

As per claims 4, 16, and 24, Ferlitsch discloses a recording medium in which a program for making a computer execute processing, the processing, comprising:

discriminating whether a receiving apparatus of a recipient of an e-mail to be transmitted with data as an attachment is an internet facsimile apparatus; ([0025])

deciding a format of the data to be attached to the e-mail depending on the discriminated result; ([0036])

re-formatting the data into the decided format if the current format of the data is different from the decided format; ([0036])

attaching one of the re-formatted data having the decided format or the current format data having the decided format as an attachment to the e-mail; and ([0036])

transmitting one of the re-formatted data having the decided format and the current format data having the decided format to an address of the recipient as the attachment of the e-mail; ([0036])

Ferlitsch fails to disclose transmission of the e-mail is confidential and wherein the decided format relates to limiting the ability of a user associated with the email to electronically handle the data. Bandini discloses transmission of the e-mail is confidential and wherein the decided format relates to limiting the ability of a user associated with the email to electronically handle the data. ([0035]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Ferlitsch to disclose transmission of the e-mail is confidential and wherein the decided format relates to limiting the ability of a user associated with the email to electronically handle the data. The motivation for doing so would have been to provide centralized control over e-mail messages exiting and entering an organization. ([0006])

As per claim 8, Ferlitsch / Bandini disclose the recording medium as recited in claim 4. Bandini discloses wherein, in cases where the data is transmitted simultaneously to a plurality of recipients, ([0024]) the program stored in the recording medium makes the computer decide the format of the data every recipient and format the data into respective decided formats. ([0032]; [0036]; Policies can advantageously be applied to users, either individually or by e-mail domains)

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirani et al. - hereinafter Kirani (US 2002/0016818) / Bandini (US 2002/0169954) further in view of Ferlitsch (US 2006/0209342)

As per claim 18, Kirani / Bandini disclose the e-mail transmitting apparatus as recited in claim 13. Kirani fails to disclose further comprising further comprising an original document reading apparatus to obtain image data by reading an original document, wherein the image data read by the original document reading apparatus is transmitted as attached data of the e-mail. Ferlitsch discloses further comprising further comprising an original document reading apparatus to obtain image data by reading an original document, ([0010]; fax machine) wherein the image data read by the original document reading apparatus is transmitted as attached data of the e-mail. ([0036]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Kirani to disclose an original document reading apparatus to obtain image data by reading an original document, wherein the image data read by the original document reading apparatus is transmitted as attached data of the e-mail. The motivation for doing do would have been to designate alternative methods of receiving faxes when the user is not actively connected to the service when another registered user of the fax service desires to send the user a fax. ([0025])

Allowable Subject Matter

Claims 22-23 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: A review of the prior art fails to disclose deciding a format of an email attachment based on a discriminated result or response time of a server. As per claim 22, a thorough review of the prior art fails to disclose or render obvious "detecting a

response time by executing a connection status searching command against the detected recipient's server; deciding a format of the data to be attached to the e-mail depending on the detected response time". Independent claim 23 is directed to similar inventive concepts as the prior art fails to disclose " discriminating whether a relay server having a prescribed property exists on the searched route; deciding a format of the data to be attached to the e-mail depending on the discriminated result" Examiner notes that independent claims 2-3 and 14-15 recite similar claim limitations as mentioned above. (see 101 rejections)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag R Patel whose telephone number is (571)272-7966. The examiner can normally be reached on Monday to Friday from 8:00AM to 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on (571) 272-1915.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll free).

/C. R. P./
Examiner, Art Unit 2454

/NATHAN FLYNN/
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